

Remarks

The Office Action mailed November 12, 2008, has been received and carefully reviewed. The preceding amendments and the following remarks form a full and complete response thereto. Claim 6 is amended to delete the term "exactly" from the claim language "exactly registered." Claim 12 is amended into dependent form reciting that the layer compound (6) is produced by the method according to claim 1 or 11. Claim 13 is cancelled. No new matter is added. Accordingly, claims 1, 3-12 and 14-19 are pending in the application, and are submitted for reconsideration.

Claims 6 and 7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. In particular, the Examiner indicated that claim 6 reciting that the two foils are to be "exactly registered" is indefinite in view of the phrase "in register" recited in other claims to describe the alignment of the two foils. Applicant disagrees. Nonetheless, in order to expedite prosecution and narrow the open issues, the Applicant has amended claim 6 to recite a "registered joining" by deleting the term "exactly" from the previous claim language "exactly registered joining." The Applicant requests that the rejection be withdrawn, and claims 6 and 7 be allowed.

Claims 1 and 3-11 were rejected under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 5,093,184 to Edwards (hereinafter "Edwards") in view of U.S. Patent No. 3,601,913 to Pollock (hereinafter "Pollock") and U.S. Patent No. 4,536,016 to Solomon et al. (hereinafter "Solomon"). The Applicant respectfully

traverses the rejection and submits that the cited references fail to teach or suggest each and every element of the present invention defined by claims 1 and 3-11.

Independent claim 1, from which claims 3-11 are dependent, recites a method for producing a layer compound (6) with at least two security features disposed in register to each other. The method includes the steps of providing a first carrier foil (100) with at least one first security feature and first register marks, and providing a second carrier foil (200) with at least one second security feature and second register marks. The method further includes the step of joining the first carrier foil to the second carrier foil, at least one of the two carrier foils being under tensile stress and at least one of the second or the first carrier foil being controlled in longitudinal direction and transverse direction with the help of the first and second register marks in such a way, that a layer compound is the result, in which the first and second security features are disposed in register to each other. Herein, the controlling of at least one of the second carrier foil (200) or the first carrier foil (100) is effected by stretching the carrier foil in longitudinal direction of the carrier foil.

Edwards is directed to a security paper comprising at least one elongated security element being partially embedded within the paper. The security element comprises a plurality of layers including a support layer and metallic regions such that when the exposed portions of the security element are viewed in the reflected light there are visible at least two metallic areas which form repeating patterns along the length of the element. Edwards, Abstract, column 2, lines 11 to 27

Edwards fails to disclose a method for connecting the two carrier layers 11 that is remotely similar to the method according to present claim 1. In particular, Edwards neither teaches nor suggests that "at least one of the two carrier foils being under tensile stress" and that the controlling of the first/second carrier foil "is effected by stretching the carrier foil in longitudinal direction of the carrier foil." Edwards merely shows in Fig. 12 a security element that is formed by laminating back to back two identical security elements as illustrated in Fig. 11 (column 8, lines 6 to 30 of Edwards). Edwards neither discloses nor suggests that the identical security elements in Fig. 11 are formed under a tensile stress so that either of the security elements is stretched in a longitudinal direction of the laminate.

Pollock fails to cure the above-described deficiencies of Edwards. Pollock discloses producing an identity card 20 having two exterior plastic foils 21a, 22a with magnetic layers M1 and M2 impregnated thereon. Pollock, Fig. 1. For producing the identity card 20 it is taught to interpose the card 20 between the plastic foils 21a, 22a by means of heat sealing elements 26, 27. Pollock, column 2, lines 69 to 75. The two foils 21a, 22a are "provided with sprocket holes engageable with sprockets 23a, 24a, so that the indexing of the [plastic foil] material is in conjunction with the movement of the identification card 20 through the rollers 23, 24." Pollock, column 2, lines 64 to 69. In particular, Pollock's controlled alignment of the foils 21a, 22a relative to each other neither teaches nor suggests applying tensile stress or stretching one of the two foils, for example, by decelerating or accelerating rollers 21, 22.

Further, Applicant submits that the sprocket holes of the plastic foils 21a, 22a are not the equivalent features of the first and second register marks of claim 1, since Pollock does not teach actively controlling an alignment of the foils relative to each other (at least through the disclosed sprocket holes). Pollock does not even disclose an interrelation between the sprocket holes and an alignment of the magnetic layers M1, M2 relative to the card 20. In fact, the sprocket holes only serve for synchronizing the advancement of the foils 21a, 22a with that of the card body 20 which is not advanced by the two rollers 21, 22 but in another way. Pollock, Fig. 1 and column 2, lines 6 to 8. They do not serve for disposing the magnetic layers M1, M2 in register to each other, as required by claim 1. In fact, Pollock does not teach or suggest a method for effecting an alignment of the magnetic layers M1, M2 relative to the back of the card.

The Office Action argued that the material is "stretched in a direction in that the card is advancing through the elements" upon heat sealing the card. Office Action, page 6, lines 2-3. The Applicant, however, respectfully disagree with the Examiner since the step of heat sealing suggested by Pollock does not appear to have any influence on the alignment of the foils or magnetic layers relative to each other but only provides for heat sealing the card body. Pollock, column 2, lines 62 to 75. Pollock fails to teach or suggest that the alignment of the foils relative to each other may really be *influenced* by the heating step taught by Pollock.

Solomon fails to cure the deficiencies of Edwards and Pollock. Solomon relates to producing plastic bank notes or identity card from an endless multilayered laminate

18 having transparent windows "left at intervals corresponding to each note within which [a] security device will be later inserted." Solomon, column 4, lines 17 to 20. For producing the notes, transfer devices with security elements are provided and longitudinally registered within the windows of laminate 18. Solomon, column 4, line 65 to column 5, line 17.

Solomon does not even disclose aligning two carrier foils relative to each other in such a way that security elements are disposed in register to each other. Instead, Solomon teaches registering security elements of a transfer foil with *windows* in a plastic laminate 18. In particular, Solomon does neither disclose nor suggest providing a tensile stress to at least one of the carrier foils to be joined or to stretch a foil in a longitudinal direction.

Accordingly, the person skilled in the art would not have been able to obtain any motivation or incentive from Pollock or Solomon to dispose security features provided on different carrier foils in register to each other by providing tensile stress or stretching on one or both of the carrier foils as taught by present independent claim 1. The Applicant therefore believes that presently pending claim 1 is patentable over the cited prior art.

Since independent claim 1 is allowable, dependent claims 3-11 are also allowable over the cited references for at least their dependencies thereon. The Applicant requests that the rejection be withdrawn and that claims 1 and 3-11 be allowed.

Claims 12-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,093,184 issued to Edwards (hereinafter “Edwards”). The Applicant respectfully traverses as Edwards fails to disclose each and every element of the present invention defined by claims 12-19.

Claim 12, from which claims 14-19 are dependent, is amended in dependent form to recite a layer compound (6) produced by the method according to claims 1 or 11. The layer compound (6) thus produced includes the tensile stress/stretching of the carrier foils, and the registered joining, according to claims 1 or 11. For example, the products of claim 12 include first and the second carrier foils 100, 200 that inherently show different tensile stresses or stretching. Edwards fails to disclose any laminated security elements which have different stress-related characteristics.

Claim 12 thus is not anticipated by Edwards since it fails to disclose each and every element of claim 12 which is inherent from its claim language. Claims 14-19 are also patentable over Edwards at least due to their dependencies on independent claim 12.

Claims 12-19 were provisionally rejected on the ground of non-statutory obvious type over claims 1-5, 16, 18-20 and 24 of Application No. 2005/0012326. Office Action, page 8, line 24 to page 9, line 11. The allegedly conflicting claims 1-5, 16, 18-20 and 24 have been cancelled in U.S. Patent Publication No. 2005/0012326 by the amendments filed on April 28, 2008. The Applicant thus respectfully submits that the non-obvious

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type double patenting rejection be withdrawn since the conflicting claims in the counterpart application have been cancelled.

In view of the foregoing, all rejections have been sufficiently addressed.

Applicant submits that the application is now in condition for allowance and request that claims 1, 3-12 and 14-19 be allowed and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

Respectfully submitted,

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Date

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